LAW OFFICES
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.
55 Cambridge Parkway
7th Floor
Cambridge, MA 02142

Telephone
617-452-1600

Facsimile
617-452-1666

FACSIMILE TRANSMITTAL

TO

Name: Yolanda Middleton
Firm: Docketing Dept.
Fax No.: 703.305.3602
Phone No.: 703.308.0027
Date: January 9, 2003

FROM

Name: Therese Hendricks
Phone No.: 617-452-1600
Fax # Verified by: J. Williams
 # Pages (incl. this): 11
Our File No.: 08513.7030-00000

Subject: Follow Up to Notice of Improper Request for Continued Examination

Confirmation Copy to Follow: No

TAH/LMO

PLEASE STAMP TO ACKNOWLEDGE RECEIPT OF THE FOLLOWING:

In Re Application of: Ho et al.
Application No.: 09/743,621
Filed: April 9, 2001
For: OPTICAL DEVICES

Group Art Unit: 1714
Examiner: Paul R. Michl

1. Submission Under 37 CFR 1.114
2. Request for 2-Month Extension of Time
3. Transmittal Letter
4. Check in the amount of $400.00

Dated: December 9, 2002
Docket No.: 08513.7030-00000
TAH/doyle - Mail Drop CAMB

(Due Date: 12/9/2002)

DMO 12.17.02

PATENT
Customer No. 22,852
Attorney Docket No. 08513.7030-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Ho et al.	)	Group Art Unit: 1714
	)	
Application No.: 09/743,621	)	Examiner: Edward Cain
	)	
Filed: April 9, 2001	)	
	)	
For: OPTICAL DEVICES	)	
	)	

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being sent via facsimile on January 9, 2003, to Yolanda Middleton in the Docketing Department at facsimile number (703) 305-3602 located at the Assistant Commissioner for Patents, Washington, D.C. 20231.

Judi Williams

Yolanda Middleton
Docketing Department
Commissioner for Patents
Washington, DC 20231

FOLLOW UP TO NOTICE OF IMPROPER REQUEST FOR CONTINUED EXAMINATION (RCE)

Applicant received the enclosed Notice of Improper Request for Continued Examination (RCE) mailed on October 13, 2002. In response, Applicant filed the enclosed Submission under 37 C.F.R. § 1.114, with a two month extension of time, on December 9, 2002 (copy enclosed with stamp postcard).

The Notice states that a copy of the Notice must be returned with any reply. Applicant attaches h r to both a copy of the Notice along with a copy of the December 9 reply.

Thus, Applicant believes it has complied with the requirements of the Notice and that the Notice should now be withdrawn.

Applicant requests that Ms. Middleton contact the undersigned attorney as soon as possible at:

Therese A. Hendricks
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.
55 Cambridge Parkway, Suite 700
Cambridge, MA 02142
telephone: 617.452.1600
fax: 617.452.1666
email: therese.Hendricks@finnegan.com

to confirm that no further action is required. Thank you.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 9, 2003

By: 
Therese A. Hendricks
Reg. No. 30,389

Commissioner f r Patents
United Stat[illegible] nt and Trademark Office
Washington, D.C. 20231
www.uspto.gov

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE

#15

DATE MAILED:

NOTICE OF IMPROPER REQUEST FOR CONTINUED EXAMINATION (RCE)

The request for continued examination (RCE) under 37 CFR 1.114 filed on 10/09/02 is improper for reason(s) indicated below:

☐ 1. Continued examination under 37 CFR 1.114 does not apply to an application for a design patent. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b) or a CPA under 37 CFR 1.53(d).

☐ 2. Continued examination under 37 CFR 1.114 does not apply to an application that was filed before June 8, 1995. Applicant may wish to consider filing a continuing application under 37 CFR 1.53(b) or a CPA under 37 CFR 1.53(d).

☐ 3. Continued examination under 37 CFR 1.114 does not apply to an application unless prosecution in the application is closed. If the RCE was accompanied by a reply to a non-final Office action, the reply will be entered and considered under 37 CFR 1.111. If the RCE was not accompanied by a reply, the time period set forth in the last Office action continues to run from the mailing date of that action.

☐ 4. The request was not filed before payment of the issue fee, and no petition under 37 CFR 1.313 was granted. If this application has not yet issued as a patent, applicant may wish to consider filing either a petition under 37 CFR 1.313 to withdraw this application from issue, or a continuing application under 37 CFR 1.53(b).

☐ 5. The request was not filed before abandonment of the application. The application was abandoned, or proceedings terminated on ____________________. Applicant may wish to consider filing a petition under 37 CFR 1.137 to revive this abandoned application.

☐ 6. The request was not accompanied by the fee set forth in 37 CFR 1.17(e) as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.

☑ 7. The request was not accompanied by a submission as required by 37 CFR 1.114. Since the application is not under appeal, the time period set forth in the final Office action or notice of allowance continues to run from the mailing date of that action or notice.

Note: If a request for a continued prosecution application (CPA) under 37 CFR 1.53(d) has been filed in the utility or plant application (including a previously filed CPA) that was filed on or after May 29, 2000, the **request for a CPA has been treated as a RCE** because the CPA practice no longer applies to such application. The constructive RCE, however, is improper for reason(s) indicated above.

A copy of this notice MUST b returned with any reply.

Direct the reply and any questions about this notice to:

[signature], Examining Group 1700.

(703) 308-9556

FORM PTO-2051 (Rev. 3/2001)

JAN.09 2003 14:19 FR FINNEGAN HENDERSON 617 452 1666 TO 6302085137030*00 P.04

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,621	04/09/2001	Peter Ho	C1043/7030	6126

22852 7590 10/18/2002

FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20006

703-308-0042 (ph)

EXAMINER
CAIN, EDWARD J

ART UNIT	PAPER NUMBER
1714	15

DATE MAILED: 10/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

OCT 24 2002

FINNEGAN, HENDERSON, FARABOW,
GARRETT AND DUNNER, LLP

Docketed 10/23/02 Attorney JAH/KMO
Case 8513.7030
Due Date 11/18/02 w/ ext
Action Final Rej / N-Appeal - 1st ext
By 2A

10-24-02

PTO-90C (Rev. 07-01)

PATENT
Custom r No. 22,852
Attorney Docket No. 08513.7030-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
Ho et al.	Group Art Unit: 1714
Application No.: 09/743,621	Examiner: Paul R. Michl
Filed: April 9, 2001	
For: OPTICAL DEVICES	

Commissioner for Patents
Washington, DC 20231

SUBMISSION UNDER 37 CFR 1.114

On October 9, 2002, applicant filed a Request For Continued Examination (RCE) under 37 CFR 1.114. Applicant now submits a response to the final office action dated July 9, 2002.

The claims were rejected under section 103(a) as being obvious over Suzor (US 4,234,350) and various other documents. The examiner argues that:

(a) applicant's assertion that particles of salt and sugar are too large to be nanoparticles was unsupported by evidence;

(b) salt or sugar when existing as dissolved molecules in water would be of nanoparticle size, and therefore "within the scope of the claims"; and

(c) that the phrase "a solution of nanoparticles" would not be understood by the skill d person.

It appears from the examiner's argument that (a) and (b) above are of relevance only as to Suzor.

Regarding (a), applicant maintains that the common salt and sugar particles to which the examiner refers are not nanoparticles; applicants are obtaining a declaration on that point. However, in relation to Suzor the question of the size of salt or sugar particles is irrelevant. Firstly the size of salt particles is irrelevant since Suzor relates exclusively to purification of sugar (not salt) solutions. There is nothing in Suzor that would lead the skilled person to adapt the system of Suzor for use with salt. Secondly, the essence of the examiner's argument is that it would have been obvious to adapt Suzor by dissolving nanoparticles of sugar in water and then separating impurities (presumably by the process disclosed in Suzor, although the examiner has not identified this). But the process of Suzor takes as its starting point an evaporated sugar liquor (see column 4, lines 64-67 and claim 1), so if the skilled person were to want to adapt Suzor in such a way, the sugar would already be in solution when the process of Suzor was applied. (Applicant's comments below in relation to (b) are relevant here).

Regarding points (b) and (c), again applicants are obtaining a declaration. However, the incorrect premise on which these arguments are based is the examiner's failure to give adequate weight to the word "particle" as used in the claim. Under point (b) the examiner argues that because individual molecules would be of nanoparticle size they would be within the scope of the claims (by which applicant assumes the examiner means they would be nanoparticles). This argument overlooks the fact that such molecules would not be particles. The examiner has given no indication of how the molecules could be particles.

In addition to being improper for ignoring the word "particle", the examiner's argument is inconsist nt. If the only characterizing feature of a nanoparticl were its size then any sufficiently small molecule or atom, including those of a liquid (e.g. a solvent) itself, would be nanoparticles. But the examiner himself (see the paragraph bridging pages 3 and 4 of the first office action) and the prior art the examiner relies on (see, for instance, the abstract of US 5,874,429) **distinguish** between "liquids" and "nanoparticles". More specifically in relation to point (c), the examiner has argued that Schroder and Fessi disclose solutions of nanoparticles (see page 4, line 4 of the first office action). It is improper for the examiner to take multiple different positions on the meaning of "nanoparticle" and "solution of nanoparticles". If proper weight were given to the word "particle" then it is apparent that molecules of salt and sugar in solution could not be nanoparticles.

In regard to the referencs other than Suzor, the examiner has ignored applicant's response to the first office action that none of those documents is concerned with the preparation of nanoparticles from a mixture of nanoparticles with another material.

In view of the foregoing remarks, applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.

Dated: December 6, 2002

By: _____
Therese A. Hendricks
Reg. No. 30,389